APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,384	12/12/2003	Greg Elliot Merriam	BLD91990020US2	9768

46919   7590   08/17/2005

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EXAMINER
DUNCAN, MARC M

ART UNIT	PAPER NUMBER
2113	

DATE MAILED: 08/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

Office Action Summary	Application No. 10/734,384	Applicant(s) MERRIAM, GREG ELLIOT
	Examiner Marc Duncan	Art Unit 2113	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on *12 December 2003*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *2,3,5,7-10,12-15 and 17-30* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *2,3,5,7-10,12-15 and 17-30* is/are rejected.

7)☒ Claim(s) *2,5,8,12,15,24 and 26* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *12 December 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Status of the Claims

Claims 14, 21, 22 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 23-30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 2, 3, 5, 7, 8, 10, 12-15, 17, 18, 20-28 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barrick, Jr. et al. (6,006,260) in view of Johnson, II et al. (6,397,245).

Claims 9, 19 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barrick in view of Johnson as applied to claims 21, 22 and 23 above, and further in view of Bellovin et al. (5,870,557).

Claims 3, 13 and 25 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2 and 3 of U.S. Patent No. 6,697,969 B1 to Merriam.

Claims 2, 5, 8, 12, 15, 24 and 26 are objected to.

Claim Objections

Claims 2, 12 and 24 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s)

in proper dependent form, or rewrite the claim(s) in independent form. The claims fail to further limit the independent claims from which they depend. The limitation of "determining the performance data comprises determining a network transmission time to download the object from the server," as contained in each of the claims that are objected to, is already contained in each of the respective parent claims.

Claims 5, 8, 15 and 26 are objected to because of the following informalities: Claims 5, 15 and 26 appear to be missing a word in line 2 of each claim. The examiner believes the claim is meant to read "displays the performance data." Claim 8 contains a semicolon at the end of line 2. The line should end in a colon. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 14, 21, 22 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Each of the claims contains the limitation "wherein the program displays the performance data at the customer computer being diagnosed and average performance data." It is unclear whether the claim intends for the average performance data to be displayed and, if so, where the average performance data is to be displayed. It is clear from the claim language that the determined performance data is displayed at the

customer computer. It is not clear, however, what is being done with the average

performance data.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 23-30 are rejected under 35 U.S.C. 101 because the claimed invention is

directed to non-statutory subject matter. Claims 23-30 are not limited to tangible

embodiments. In view of Applicant's disclosure. Specification page 15, lines 17-22, the

medium is not limited to tangible embodiments, instead being defined as including both

tangible embodiments (e.g., magnetic storage media) and intangible embodiments (e.g.,

carriers, file server transmitting the program over a transmission line). As such, the

claim is not limited to statutory subject matter and is therefore non-statutory.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1.   Determining the scope and contents of the prior art.
2.   Ascertaining the differences between the prior art and the claims at issue.
3.   Resolving the level of ordinary skill in the pertinent art.
4.   Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 2, 3, 5, 7, 8, 10, 12-15, 17, 18, 20-28 and 30 are rejected under 35 U.S.C.

103(a) as being unpatentable over Barrick, Jr. et al. (6,006,260) in view of Johnson, II et

al. (6,397,245).

Regarding claim 21:

Barrick teaches transmitting a program (col. 2 lines 20-22 – browser agent) to

execute on a customer computer (col. 2 lines 20-22 – the user machine represents a

customer computer).

Barrick teaches the program causing the customer computer to perform:

(i) downloading at least one object from a server to the customer computer over

the network (col. 2 lines 22-25 – an HTTP GET request is a request for download that is

initiated by the browser agent) to diagnose performance problems with the customer

computer (col. 1 lines 54-56 and col. 4 lines 66-67 – the information is clearly used in

some embodiments to diagnose problems);

(ii) determining performance data comprising a network transmission time to

download the object from the server to the customer computer over the network (col. 2

lines 25-28);

(iii) displaying the determined performance data at the customer computer being

diagnosed (col. 8 lines 10-11) and average performance data (col. 2 lines 8-12) to

provide information to diagnose the customer's computer (col. 1 lines 54-56 and col. 4

lines 66-67 – the information is clearly used in some embodiments to diagnose

problems);

(iv) transmitting the determined performance data to the diagnostic system over

the network (col. 4 lines 60-67); and

Barrick does not explicitly teach initiating a customer service session to provide

technical support of the customer computer. Barrick does not explicitly teach using the

performance data transmitted to the diagnostic system to provide technical support for

the customer computer. Barrick does, however, teach sending performance data to a

provider or a service center (col. 4 lines 60-67).

Johnson explicitly teaches initiating a customer service session to provide

technical support of the customer computer (col. 8 lines 24-34) and using the

performance data transmitted to the diagnostic system to provide technical support for

the customer computer (col. 8 line 64-col. 9 line 2 and col. 9 lines 14-18).

It would have been obvious to one of ordinary skill in the art at the time of

invention to combine the performance data determination of Barrick with the diagnosis

method of Johnson.

One of ordinary skill in the art at the time of invention would have been motivated

to make the combination because Barrick explicitly states a desire to gather data in

order to provide support when a problem is reported (Barrick col. 1 lines 54-56).

Furthermore, Barrick teaches a user accessing a web site in order to initiate the

gathering of the performance data (col. 2 lines 20-22) and sending the performance

data to a support center (col. 4 lines 66-67).

Regarding claim 2:

Claim 2 is not further limiting. See the teachings of Barrick and Johnson with

respect to claim 21.

Regarding claim 3:

Barrick teaches wherein the diagnostic computer stores the performance data as

a record in a database in col. 4 lines 63-64.

Regarding claim 5:

Barrick teaches wherein the diagnostic program displays the performance data

from the customer computer being diagnosed and average performance data

determined from the database at the server to provide information to diagnose the

customer computer in col. 2 lines 5-12.

Regarding claim 7:

Barrick teaches wherein providing the program comprises transmitting the

program over the network to diagnose the customer computer in col. 2 lines 20-22.

Regarding claim 8:

Barrick teaches detecting a presence of a condition occurring as a result of

downloading the at least one object from the server (col. 8 lines 62-66 – download

timing information is a detected condition);

Barrick teaches building an electronic message addressed to the diagnostic

computer including information on the detected condition (col. 8 lines 62-66 – the HTTP

GET request header is an electronic message);

Barrick teaches transmitting the electronic message to the diagnostic computer

over the network (col. 8 lines 62-66).

Regarding claim 10:

Barrick teaches wherein the diagnostic program comprises an applet that

executes within an Internet web browser program executing on the customer computer

in col. 4 lines 45-47.

Regarding claim 22:

The claim is rejected as the means for performing the method of claim 21. The

method of claim 21 is performed by the combination of Barrick and Johnson. The

means for performing the method are therefore necessarily present.

Regarding claim 12:

Claim 12 is not further limiting. See the teachings of Barrick and Johnson with respect to claim 22.

Regarding claim 13:

The claim is rejected as the means for performing the method of claim 3. The method of claim 3 is performed by the combination of Barrick and Johnson. The means for performing the method are therefore necessarily present.

Regarding claim 14:

Barrick teaches wherein the diagnostic program displays the performance data from the customer computer being diagnosed and average performance data determined from the database at the server to provide information to diagnose the customer computer in col. 2 lines 5-12.

Regarding claim 15:

The claim is rejected as the means for performing the method of claim 5. The method of claim 5 is performed by the combination of Barrick and Johnson. The means for performing the method are therefore necessarily present.

Regarding claim 17:

Barrick teaches wherein the program is transmitted over the network to diagnose the customer computer in col. 2 lines 20-22.

Regarding claim 18:

Barrick teaches detecting a presence of a condition occurring as a result of

downloading the at least one object from the server (col. 8 lines 62-66 – download

timing information is a detected condition);

Barrick teaches building an electronic message addressed to the diagnostic

computer including information on the detected condition (col. 8 lines 62-66 – the HTTP

GET request header is an electronic message);

Barrick teaches transmitting the electronic message to the diagnostic computer

over the network (col. 8 lines 62-66).

Regarding claim 20:

Barrick teaches wherein the diagnostic program comprises an applet that

executes within an Internet web browser program executing on the customer computer

in col. 4 lines 45-47.

Regarding claim 23:

The claim is rejected as the computer readable storage medium embedded with

a computer program that causes the method of claim 21 to be performed.

Regarding claim 24:

Claim 24 is not further limiting. See the teachings of Barrick and Johnson with respect to claim 23.

Regarding claim 25:

The claim is rejected as the computer readable storage medium embedded with a computer program that causes the method of claim 3 to be performed.

Regarding claim 26:

The claim is rejected as the computer readable storage medium embedded with a computer program that causes the method of claim 5 to be performed.

Regarding claim 27:

The claim is rejected as the computer readable storage medium embedded with a computer program that causes the method of claim 7 to be performed.

Regarding claim 28:

The claim is rejected as the computer readable storage medium embedded with a computer program that causes the method of claim 8 to be performed.

Regarding claim 20:

The claim is rejected as the computer readable storage medium embedded with a computer program that causes the method of claim 10 to be performed.

Claims 9, 19 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barrick in view of Johnson as applied to claims 21, 22 and 23 above, and further in view of Bellovin et al. (5,870,557).

Regarding claim 9, 19 and 29:

The teachings of Barrick and Johnson are outlined above.

Barrick and Johnson do not explicitly teach wherein the performance data includes trace route data indicating the route packets comprising the object travel through the network when transmitted from the server to the computer. Barrick and Johnson do, however, teach that the performance data may be any type of performance parameter that is desired (see Barrick col. 10 lines 60-61).

Bellovin et al. teach obtaining trace route data (Abstract lines 1-4).

It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Barrick and Johnson with the route trace teaching of Bellovin et al.

One of ordinary skill in the art at the time of invention would have been motivated to combine the two teachings because Barrick and Johnson teach that the performance data could be any type of performance parameter that is desired (see Barrick col. 10 lines 60-61) and Bellovin teaches that trace route data is desirable because it is desirable for users to be able to know how congested the traffic route is from their entry point onto the Internet to a web site of interested (Bellovin col. 2 lines 3-5).

Double Patenting

The non-statutory double patenting rejection is based on a judicially created

doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

unjustified or improper time wise extension of the "right to exclude" granted by a patent

and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11

F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225

USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA

1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,*

418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be

used to overcome an actual or provisional rejection based on a non-statutory double

patenting ground provided the conflicting application or patent is shown to be commonly

owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a

terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with

37 CFR 3.73(b).

Claims 3, 13 and 25 are rejected under the judicially created doctrine of

obviousness-type double patenting as being unpatentable over claims 1, 2 and 3 of U.S.

Patent No. 6,697,969 B1 to Merriam. Although the conflicting claims are not identical,

they are not patentably distinct from each other because it is well settled that the

omission of an element and its function is an obvious expedient if the remaining

elements perform the same function as before. In re Karlson, 136 USPQ 184 (CCPA 1963).

Claim 1 of U.S. Patent No. 6,697,969 B1 to Merriam teaches the following:

A method for diagnosing a customer computer over a network, comprising:

initiating a customer service session to provide technical support of a customer computer;

transmitting a program to execute on the computer, wherein the program causes the customer computer to perform:

(i) downloading at least one object from a server to customer computer over a network;

(ii) determining performance data comprising a network transmission time to download the object from the server to the customer computer over the network to diagnose performance problems with the customer, wherein a diagnostic system stores the performance data as a record in a database;

(iii) displaying the determined performance data at the customer computer being diagnosed and average performance data determined from the database to provide information to diagnose the customer computer;

(iv) transmitting the determined performance data to the diagnostic system over the network;

determining a network transmission time for a probe computer that is in a proximate location with respect to the server to download the at least one object from the server;

using the network transmission time for the probe computer to determine a

server load delay time and a network-only delay time which indicates time to downlad

the at least one object from the server to the customer computer that does not include

the server load delay; and

using the performance data transmitted to the diagnostic system to provide

technical support for the customer computer.

Applicant's current claim 3 does not teach:

determining a network transmission time for a probe computer that is in a

proximate location with respect to the server to download the at least one object from

the server;

using the network transmission time for the probe computer to determine a

server load delay time and a network-only delay time which indicates time to downlad

the at least one object from the server to the customer computer that does not include

the server load delay

Applicant has clearly removed elements from a patented claim along with their

respective function as an obvious expedient.

The rejection of instant claim 3 above is representative of the rejection of each of

claims 3, 13 and 25.

Conclusion

The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc Duncan whose telephone number is 571-272-3646. The examiner can normally be reached on M-F 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Beausoliel can be reached on 571-272-3645. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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